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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/541,148	06/30/2005	Ricardo Perez Oca	2273-0121PUS1	4531
2292	7590	03/08/2007		
BIRCH STEWART KOLASCH & BIRCH	EXAMINER			
PO BOX 747	PEDDER, DENNIS H			
FALLS CHURCH, VA 22040-0747	ART UNIT		PAPER NUMBER	
	3612			
SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE		
3 MONTHS	03/08/2007	ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 03/08/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/541,148	PEREZ OCA ET AL.
	Examiner Dennis H. Pedder	Art Unit 3612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 12 February 2007.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-3 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-3 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 30 June 2005 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Drawings*

1. The drawings were received on 2/12/2007. These drawings are not approved. There is no support in this application as filed for the structural detail proposed. These drawings are considered to contain new matter in this application, not supported as filed.
  
2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the stops for the mechanism pivots, and spring coupled to the cable, claim 1, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will

be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase “or by similar means” is indefinite under this statute as determination of potential infringement is not possible.

No stops for the pivots are apparently disclosed.

“The cable drum”, “the ends of the sides”, “the mechanism pivots” all lack antecedent basis, claim 1. The filing of a literal translation does not comport with U.S. patent law and should be revised or replaced in order to avoid extended prosecution for these types of problems.

Claim 1 is not generic to claim 3 as it is not apparently possible for an injected frame to be metal alloy, and extruded as disclosed, as best understood.

Claim 5 is indefinite in “when necessary” under this statute.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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4. Claims 1-3 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

No stops for the pivots are apparently disclosed and the claim is not understood via the disclosure.

It is not disclosed how metal alloy is injected, claim 3.

The inclusion of reference to structure not disclosed as filed is considered to be new matter and must be deleted from the specification.

#### *Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schliecher et al. DE 4012635 (635), in view of Imgram et al., Coenen, Lenhart et al. and Hayashi et al.

The claims continue to appear to be a compilation of known elements from this art. For example, Schliecher et al. teach the claimed supporting frame of injection molded plastic U-shaped structure, with orificed protrusions 8 lacking the centered extension covering a drive element for the roof, a detail taught by Imgram et al. at the motor 19. Coenen teach the cable drive mechanism with cable connections as claimed including reroutings at 5,6,7 at corners. Coenen uses segments of the cable at each of the claimed locations.

Schliecher et al. have lateral channels for the slide elements at 4 and Hayashi et al. teach that recesses 26 in the lateral channels allow vertical mounting of the sliding elements 24.

Lenhart et al. teaches the prior art known use of a spring 18 coupled to a drive cable 24. It would have been obvious to one of ordinary skill to provide in Schliecher et al. the center extension for mounting the drive motor as taught by Imgram et al. as a necessary attachment point, a drive cable mechanism as taught by Coenen as a known drive in this art, recesses in the lateral channels as taught by Hayashi et al. in order to allow venting of the roof panel and a spring coupled to a drive cable for a sunroof as taught by Lenhart et al. in order to assist closing force.

8. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schliecher et al. (635) in view of Imgram et al., Bohm et al. Lenhart et al. and Hayashi et al. as applied to claim 1 above, and further in view of Maeda et al.

Schliecher et al. have the cable routings and it would have been obvious to one of ordinary skill to provide in the references above integral drain tubes as taught by Maeda et al. in figure 3 at 10.

9. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schliecher et al. (635) in view of Imgram et al., Bohm et al. Lenhart et al. and Hayashi et al. as applied to claim 1 above, and further in view of Masuda, Maeda et al. and Bienert.

The claim is not logical in the material, but Masuda teaches an aluminum alloy frame of U-shape with tabs 5. Auxiliary pieces at front are disclosed by Maeda et al. at 7 and rear by Bienert at 26. Locating the reroutings at these locations is disclosed by the Coenen patent above and hence, in view of these teachings it would have been obvious to form the frame of metal alloy as taught by Masuda for durability and to form corner and end pieces separately as taught by Maeda et al. and Bienert in order to manufacture complex shapes in an economical manner.

#### *Response to Arguments*

10. Applicant's arguments filed 2/12/2007 have been fully considered but they are not persuasive.

Applicant argues that even though the applicant is charged with knowledge of his art, there is no motivation to combine these prior art teachings as suggested. This is an invalid argument as motivation was supplied for each and every modification involving the above rejections. As to the invalidity of the Bohm et al. reference, the Coenen reference, predating Bohm et al. is now supplied.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis H. Pedder whose telephone number is (571) 272-6667. The examiner can normally be reached on 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn D. Dayoan can be reached on (571) 272-6659. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Dennis H. Pedder  
Primary Examiner  
Art Unit 3612

3/5/07

DHP  
3/5/2007